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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,464	05/24/2004	Takeshi Sakamoto	118870	9230

25944 7590 10/22/2007

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EXAMINER	
WONG, EDNA	
ART UNIT	**PAPER NUMBER**
1795	

MAIL DATE	DELIVERY MODE
10/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/788,464	SAKAMOTO ET AL.	
	Examiner	Art Unit	
	Edna Wong	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3 and 5-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3 and 5-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 3, 2007 has been entered.

This is in response to the Amendment dated September 10, 2007. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Rejections - 35 USC §103

I. Claims **1-3 and 5-8** have been rejected under 35 U.S.C. 103(a) as obvious over **JP 2002-212775** ('775) [Oshima] in combination with **Du Rose et al.** (US Patent No. 3,183,067).

With regards to claim **2**, the rejection under 35 U.S.C. 103(a) as obvious over JP 2002-212775 ('775) in combination with Du Rose et al. has been withdrawn in view of Applicants' amendment. Claim 2 has been cancelled.

claims result in unexpected and superior results over methods with compositions different from the claimed compositions and outside of the specified ranges.

In response, the Examiner deems that the prior art methods with compositions are not deemed to be different from the claimed compositions and outside of the specified ranges because:

Claim 1 recites:

A method of manufacturing a rare-earth magnet, comprising the steps of:
electroplating a first protective film including nickel on a magnet body including a rare-earth element with a first plating bath of water solution substantially not including a ligand which complexes nickel, the first plating bath including a nickel source, a conductive salt and a pH stabilizer, and having a concentration of the nickel source of ***0.3 mol/l to 0.7 mol/l*** on a nickel atom basis and a conductivity of ***80 mS/cm or over***, the nickel source selected from the group consisting of nickel sulfate, nickel chlorides and nickel bromides and a pH stabilizer selected from the group consisting of boric acid, sodium borate, potassium borate, lithium borate and magnesium borate; and
forming a second protective film including nickel and sulfur on the first protective film.

Claim 9 recites:

A method of manufacturing a rare-earth magnet, comprising the steps of:
electroplating a first protective film including nickel on a magnet body including a rare-earth element with a first plating bath of water solution substantially not including a ligand which complexes nickel, the first plating bath including ***0.3 mol/l to 0.7 mol/l*** of nickel ions, at least one ion selected from the group consisting of sulfate ions, chlorine ions, and bromine ions, at least one ion selected from the group consisting of sodium ions, potassium ions, lithium ions and magnesium ions, at least one ion selected from the group consisting of borate ions, and semi-brightener and having a conductivity of ***80 mS/cm or over***, and
forming a second protective film including nickel and sulfur on the first protective film.

Applicants have not shown that the plating baths disclosed by JP '775 do not have a conductivity of 80 mS/cm or over, and the Examiner maintains that it would have

With regards to claims ***1, 3 and 5-8***, the rejection under 35 U.S.C. 103(a) as obvious over JP 2002-212775 ('775) in combination with Du Rose et al. is as applied in the Office Actions dated November 15, 2006 and May 9, 2007 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that Oshima *does not disclose a first plating bath of water solution substantially not including a ligand which complexes nickel*. Oshima teaches oxycarboxylic acids acting as buffers. Oxycarboxylic, however, is a ligand which complexes with nickel, as is well known in the art. Thus, Oshima neither teaches a pH stabilizer selected from the group positively recited in claim 1 nor a first plating bath of water solution substantially not including a ligand which complexes nickel, as recited in claims 1 and 9.

In response, the claim language of "substantially not including a ligand" does not exclude an oxycarboxylic acid from being in the first plating bath.

The transitional term "comprising", which is synonymous with "*including*", "containing", or "characterized by", is inclusive or open-ended and does not excludes additional, unrecited elements or methods steps (MPEP § 2111.03)

The term "*substantially*" is a broad term (MPEP § 2173.05(b)(D)).

Oshima teaches using 0 to 15 g/l boric acid (abstract; page 1, [0002]; and page 3, [0009]).

Applicants state that the combination of all of the features recited in the pending

been obvious to add a sulfur compound to the second plating bath to form a second protective film including sulfur in view of Du Rose.

The presently claimed compounds and concentrations overlap with the prior art, thus, the combination of all of the features recited in the pending claims would have been obvious in view of the prior art.

II. Claims **9 and 10** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 2002-212775** ('775) in combination with **Du Rose et al.** (US Patent No. 3,183,067) and **Martin** (US Patent No. 2,986,501).

The rejection of claims 9 and 10 under 35 U.S.C. 103(a) as being unpatentable over JP 2002-212775 ('775) in combination with Du Rose et al. and Martin is as applied in the Office Action dated May 9, 2007 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

Response to Amendment

Declaration

The declaration under 37 CFR 1.132 filed September 10, 2007 is insufficient to overcome the rejection of claims 1-3 and 5-10 based upon specific references applied under 35 USC § 103 as set forth in the last Office action because Tables 1 and 2 show

results from using concentrations outside the presently claimed ranges but fail to show where the prior art conditions fall within these results and concentrations.

Claim Rejections - 35 USC § 112

I. Claims **1, 3 and 5-10** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 9

lines 4-5, recites "water solution substantially not including a ligand which complexes nickel".

Applicants' specification, pages 1-31, does not mention a water solution substantially not including a ligand which complexes nickel. Thus, there is insufficient written description to inform a skilled artisan that applicant was in possession of the claimed invention as a whole at the time the application was filed (MPEP § 2173.05(i)).

The Examiner has carefully considered the entire specification as originally filed, however, there is found no literal support in the specification for the newly added limitations in amended claims 1 and 9. Applicants have not provided the page number and line numbers from the specification as to where the newly added limitations are coming from. *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.* 738 F.2d

453 (Fed. Cir. 1984).

II. Claims **1, 3 and 5-10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1

line 10, it appears that "a pH stabilizer" is the same as the pH stabilizer recited in claim 1, line 6. However, it is unclear if it is. If it is, then it is suggested that the word "a" be amended to the word -- the --.

Claim 9

lines 9-10, recites "at least one ion selected from the group consisting of borate ions, and semi-brightener". The alternative expression of the Markush group is improper (MPEP § 2173.05(h)) because the semi-brightener is not an ion.

Claim 10

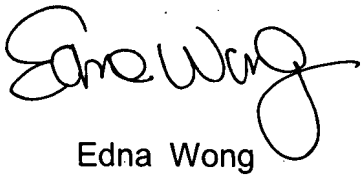
lines 7-8, recites "at least one ion selected from the group consisting of borate ions". The alternative expression of the Markush group is improper (MPEP § 2173.05(h)) because borate ions alone are not a group of species.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Edna Wong
Primary Examiner
Art Unit 1795

EW
October 19, 2007